

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLICATION NO. 10/779,859
ATTORNEY DOCKET NO. Q79849

REMARKS

Applicants thank the Patent Office for acknowledging Applicants' claim to foreign priority, and for indicating that the certified copy of the priority documents, Russian Patent Application No. 2003-105184, filed on February 18, 2003, and Russian Patent Application No. 2003-107773, filed on March 17, 2003, has been made of record in the file.

Applicants thank the Patent Office for initialing the references listed on the PTO/SB/08 A & B form submitted with the Information Disclosure Statement filed on February 18, 2004 and returning an initialed copy of the PTO/SB/08 A & B, thereby confirming that the listed references have been considered.

Claims 1-23 have been examined on their merits.

Claims 1-23 are all the claims presently pending in the application.

1. The Patent Office objects to the specification as containing terms that are allegedly not clear, concise and exact. Applicants traverse the objection to the specification for at least the following reasons.

The term "acryl" has been amended to recite "acryl material." Although Applicants believe that the term "acryl" by itself would be understood by one of ordinary skill in the art (and given the number of hits on the term "acryl" when searched on the Internet), Applicants are amending the term to advance prosecution of this application.

The phrase "positive element" has been amended to "positive component" and a definition has been added to the specification based on Figures 2 and 4 of the instant application.

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The definition of the phrase “negative element” has been deleted from the specification, since the definition in the specification did not differ from the accepted meaning as indicated by the Patent Office at page 4 of the May 4, 2005 Office Action.

The phrase “convex lens” has been amended to “double convex lens” where appropriate.

The phrase “hologram optical element” has been amended to “holographic optical element” where appropriate.

The phrase “focal power” has been amended to “magnifying power” where appropriate.

Based on the foregoing, Applicants submit that the objections to the specification have been overcome, and respectfully request that the Patent Office withdraw the objection.

2. Claims 1-23 stand rejected under 35 U.S.C. § 112 (1st para.) as allegedly being based on a disclosure that is non-enabling. Applicants traverse the § 112 (1st para.) rejection of claims 1-23 for at least the reasons discussed below.

The test of enablement is whether one reasonable skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.¹ Several factors must be considered when determining whether a disclosure satisfies the enablement requirement and whether any necessary experimentation is “undue”. As set forth in MPEP § 2164.01(a), the factors include, but are not limited to:

¹ *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988); *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916); *In re Wands*, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed. Cir. 1988).

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- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention.

Here, the Patent Office has addressed none of these factors. The Patent Office's analysis must consider all the evidence related to each of these factors, and any conclusion of non-enablement must be based on the evidence as a whole. *See* MPEP § 2164.01(a). Instead, the Patent Office simply states, without any supporting rationale, that the lens system would not have sufficient optical power for image focusing and/or image formation without the auxiliary lens element. At paragraph [0041], the instant specification states that the auxiliary element (117, 317), which is a double-convex lens additionally disposed between the negative element N and the positive component P, improves the focusing ability of the objective lens system 100. Critically, the Patent Office has not cited any text passage in the instant specification that unequivocally states that the auxiliary element is necessary for the invention to work without undue experimentation. In addition, limitations and examples in the specification do not generally limit what is covered by the claims. MPEP § 2164.08(a). Therefore, the mere fact that Figures 2-5 of the instant specification illustrate the auxiliary element (117, 317) is not dispositive that the auxiliary element (117, 317) must be recited in the independent claims.

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Thus, Applicants submit that the § 112 (1st para.) rejection of claims 1-23 has been overcome, and request that the Patent Office reconsider and withdraw the § 112 (1st para.) rejection of claims 1-23.

3. Claims 1-23 stand rejected under 35 U.S.C. § 112 (2nd para.) as allegedly being incomplete for omitting essential elements. The rejection of claim 14 is now moot due to its cancellation. Applicants traverse the § 112 (2nd para.) rejection of claims 1-13 and 15-23 for at least the reasons discussed below.

As discussed above, at paragraph [0041], the instant specification states that the auxiliary element (117, 317), which is a double-convex lens additionally disposed between the negative element N and the positive component P, improves the focusing ability of the objective lens system 100. The Patent Office has not cited any text passage in the instant specification that unequivocally states that the auxiliary element is absolutely necessary for the invention to operate. Furthermore, as noted above, limitations and examples in the specification do not generally limit what is covered by the claims. MPEP § 2164.08(a). Therefore, the mere fact that Figures 2-5 of the instant specification illustrate the auxiliary element (117, 317) is not dispositive that the auxiliary element (117, 317) must be recited in the independent claims.

Thus, Applicants submit that the § 112 (2nd para.) rejection of claims 1-23 has been overcome, and respectfully request that the Patent Office reconsider and withdraw the § 112 (2nd para.) rejection of claims 1-13 and 15-23.

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4. Claims 1-23 stand rejected under 35 U.S.C. § 112 (2nd para.) as allegedly being indefinite. Applicants traverse the § 112 (2nd para.) rejection of claims 1-23 for at least the reasons discussed below.

Applicants herein amend claims 1, 2, 4, 6-10, 13 and 15-23 to correct the various terms and/or phrases that the Patent Office indicated as being indefinite. Applicants submit that the § 112 (2nd para.) rejection of claims 1-13 and 15-23 has been overcome, and respectfully request that the Patent Office reconsider and withdraw the § 112 (2nd para.) rejection of claims 1-13 and 15-23.

5. Claims 1, 8, 20 and 21 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Sakamoto *et al.* (U.S. Patent No. 6,275,342). Applicants traverse the § 102(b) rejection of claims 1, 8, 20 and 21 for at least the reasons discussed below.

Sakamoto *et al.* fail to teach or suggest at least a lens system comprising first and second negative lenses, wherein the first and second negative lenses are arranged as recited in amended independent claims 1 and 20. Based on the Patent Office's interpretation, the arrangement of elements in Sakamoto *et al.* is completely different from the present invention.

Sakamoto *et al.* fail to teach or suggest at least a lens system comprising a positive component and a negative lens, wherein the elements comprising the positive component are arranged as recited in amended independent claims 8 and 21. Based on the Patent Office's interpretation, the arrangement of elements in Sakamoto *et al.* is completely different from the present invention.

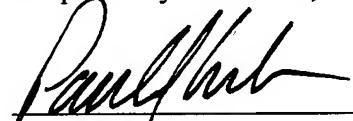
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Thus, Applicants submit that claims 1, 8, 20 and 21 are allowable, and respectfully request that the Patent Office reconsider and withdraw the § 102(b) rejection of claims 1, 8, 20 and 21.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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CUSTOMER NUMBER

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